REMARKS

In response to the final Office Action dated January 6, 2006, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 1-18 are pending in this application. The United States Patent and Trademark Office (the "Office") objected to the originally-submitted oath. The Office also rejected claims 8 and 13-16 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,867,796 to Inutsuka. Claims 1-7 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inutsuka* in view of U.S. Patent 6,459,913 to Cloutier. Claims 9-12 and 17-18 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inutsuka* in view of U.S. Patent 6,253,075 to Beghtol *et al.*

The Assignee shows, however, that the pending claims recite features not taught or suggested by any combination of *Inutsuka*, *Cloutier*, and *Beghtol*. Moreover, the patent to *Inutsuka* "teaches away" from the pending claims and, thus, cannot support a *prima facie* case for obviousness.

Objection to Oaths

The Office objects to the originally-submitted oaths for failing to state a mailing address. The originally-submitted declaration identifies a "residence" of each inventor, and this residence is an address at which each inventor receives mail. Examiner Ekong is thus respectfully requested to remove the objection.

Rejection of Claims Under 35 U.S.C. § 102

Claims 8 and 13-16 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,867,796 to Inutsuka. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,

631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Independent claims 8 and 13-16, however, are not anticipated. Independent claims 8 and 13 each recite features not taught or suggested by *Inutsuka*. Claim 8, for example, recites "*continuously presenting the calling line identification information to the subscriber for a duration of the call.*" Support for such features may be found at least at paragraphs [0006], [0007], [0019], [0023], and [0024]. A "clean" version of independent claim 8 is reproduced below.

> **[c08]** (Currently Amended) A method for alerting a subscriber of calling line identification information associated with a call, the method comprising:
>
> receiving the call at a base station, the call comprising the calling line identification information;
>
> wirelessly transmitting only the calling line identification information from a transmitter to an accessory device; and
>
> continuously presenting the calling line identification information to the subscriber for a duration of the call,
>
> wherein the subscriber is alerted to the calling line identification information associated with the call.

Claims 13-16 recite, or incorporate, similar features. Independent claim 13, for example, recites "*a display continuously presenting the calling line identification information for a duration of the call.*" A "clean" version of independent claim 13 is reproduced below.

> **[c13]** (Currently Amended) A device for alerting a subscriber of calling line identification information associated with a call, the device comprising:
>
> a receiver wirelessly receiving only the calling line identification information from a base station; and

a display continuously presenting the calling line identification information for a duration of the call,

wherein when the calling line identification information is received, the device presents the calling line identification information to the subscriber, thus informing the subscriber of the calling line identification information associated with the call.

Inutsuka fails to teach or suggest such features. *Inutsuka* does not "continuously present" calling line identification information "for a duration of the call," as independent claims 8 and 13 recite. *Inutsuka*, in contradistinction, deletes the caller's telephone number from the display when a communication is desired or when placed in a holding mode. As *Inutsuka* explains, "[w]hen operated, the holding switch 31 produces a switch operation signal." U.S. Patent 5,867,796 to Inutsuka (Feb. 2, 1999) at column 7, lines 3-4. The wireless vibration unit transmits a "holding information signal." *Id.* at column 7, lines 4-8 and lines 13-14. "[T]he holding indication signal 43 is used to place the portable telephone apparatus 11 in the holding mode." *Id.* at column 7, lines 19-20. "[T]he unit control section 32 transmits the vibration stopping command to the vibrator 29 in response to the switch operation signal" and "the vibrator 29 stops the predetermined vibration." *Id.* at column 7, lines 21-26. **"[T]he unit control section 32 makes the unit displaying section 28 delete the caller's telephone number."** U.S. Patent 5,867,796 to Inutsuka (Feb. 2, 1999) at column 7, lines 30-33 (emphasis added). "[T]he apparatus control section 24 causes the portable telephone apparatus 11 to be placed in the holding mode." *Id.* at column 7, lines 45-47. "More particularly, the apparatus control section 24 and the first radio section 16 cooperate with each other to transmit a holding signal through the first antenna 14 towards the base station 13." *Id.* at column 7, lines 45-47. "In response to the holding signal, the base station 13 transmits, towards the caller, a message representing that the user can not carry out the predetermined communication at the current time." *Id.* at column 7, lines 54-57. "This means that the apparatus control section 24 operates as a hold making arrangement." U.S. Patent 5,867,796 to Inutsuka (Feb. 2, 1999) at column 7, lines 57-58. **"When it is desired to carry out the predetermined communication at a particular time after the current time, the user operates the operating section 19 to release the holding mode."** *Id.* at column 7, lines 59-62 (emphasis added). **"When the holding mode is released,**

... it becomes possible to carry out the predetermined communication." *Id.* at column 7, lines 62-65 (emphasis added).

Inutsuka, then, cannot anticipate claims 8 and 13-16. If a user desires to "hold" an incoming call, *Inutsuka's* wireless vibration unit stops vibrating and stops presenting the caller's telephone number. *Inutsuka*, then, does not "continuously present" calling line identification information "for a duration of the call," as independent claims 8 and 13 recite. Because *Inutsuka* is silent to such features, *Inutsuka* cannot anticipate claims 8 and 13-16. Examiner Ekong is thus respectfully requested to remove the § 102 (b) rejection of claims 8 and 13-16.

Inutsuka "Teaches Away" from the Claims

The Office rejects the pending claims as being obvious over various combinations of *Inutsuka*, *Cloutier*, and *Beghtol*. As the following paragraphs explain, however, *Inutsuka* "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See* M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at § 2141.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01.

The Office's proposed combinations all require an impermissible change to *Inutsuka's* principle of operation. When *Inutsuka's* wireless vibration unit is placed into the "hold" mode, the wireless vibration unit, as explained above, stops vibrating and stops presenting the caller's telephone number. The only way for *Inutsuka* to "continuously present" calling line identification information "for a duration of the call" is to change its stated principle of operation. The patent case law, however, prohibits changing a principle of operation to support a

prima facie case. Because such changes are not permissible, *Tsukagoshi* cannot support a *prima facie* case. The *prima facie* cases for obviousness must fail, so Examiner Ekong is respectfully requested to remove the § 103 (a) rejections.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or *scott@wzpatents.com*.

Respectfully submitted,

Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390